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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT		ATTORNEY DOCKET NO.
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EXAMINER	
LEWIS,R	
ART UNIT	**PAPER NUMBER**
336	8

DATE MAILED: 03/06/90

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 12/29/89 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ~~days~~ from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☒ Notice of Art Cited by Applicant, PTO-1449
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 28-34 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☒ Claims 1-27 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 28-34 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

The references crossed out by the Examiner on PTO-1449 have been subject to a cursory review. The crossed out references appear to be of only a broad general interest and not pertinent to the case's patentability. The Examiner's basis for not citing all references submitted by the Applicant is the second requirement of 37 C.F.R. 1.98 which states that a "concise explanation of the relevance of each listed item" must be included with the information disclosure statement.

It is noted also that the classifications crossed out on PTO-1449 no longer exist.

It is further noted that the published articles titled "Flexible Balloon-Expanded Stent for Small Vessels" and "Early and Late Results of Intracoronary Arterial Stenting after Angioplasty in Dogs" list the Applicant as a co-author. In considering the patentability under 35 USC 102(f) or (g) it has been assumed by the Examiner that the other named co-authors took no part in the inventing of the claimed invention.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless-
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one (1) year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 31-34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by each of the following published articles: "Expandable intraluminal vascular graft: A feasibilitystudy", "Expandable Intraluminal Graft: A Preliminary Study", and "Expandable Intrahepatic Portacaval Shunt Stents".

Claims 31-34 of this application has been copied by the applicant from United States Patent No. 4,733,665. These claims ~~is~~ are not patentable to the applicant because the above noted articles disclosing the Palmaz stent were published over one year prior to the filing date of this application's parent.

An interference cannot be initiated since a prerequisite for interference under 37 CFR 1.606 is that the claim be patentable to the applicant subject to a judgment in the interference.

Claim 28 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Rockey.

Claim 29 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Choudhury and Mass et al.

Claims 28 and 29 are rejected under the judicially created doctrine of obviousness type double patenting as

being unpatentable over claims 1-31 of United States Patent No. 4,800,882. Although the conflicting claims are not identical, they are not patentably distinct from each other because the device set forth in the '882 claims would inherently remain a constant length when expanded, meeting the limitations of claims 28 and 29.

Applicant's arguments with respect to claims 28-34 have been considered but are deemed to be moot in view of the new grounds of rejection.

The obviousness type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Lindeman et al, Hillstead, Kreamer, and the article titled "Atherosclerotic Rabit Aortas: Expandable Intraluminal Grafting" are made of record.

Any inquiry concerning this communication should be directed to Examiner Ralph Lewis at telephone number 703-557-3125.

R. Lewis:lf
3-2-90

STEPHEN C. PELLEGRINO
PRIMARY EXAMINER
ART UNIT 336